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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,473	09/17/2003	Carey E. Garibay	BEAS-01454US7	4342
23910	7590	07/13/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			AGWUMEZIE, CHARLES C	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,473	Applicant(s) GARIBAY ET AL.	
	Examiner Charlie C. Agwumezie	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-129 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/11/05; 09/17/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-17, 19-26, 28-36, 38-41, 43-50, 52-55, 57-64, 66-94, 96-103, 105-108, 110-117, and 119-129, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143.

1. As per **claim 1, 10, 19, 29, 39, 53, 67, 77, 87, 96, 106, 120,** Aldis et al discloses a method comprising:

maintaining digital records of software licenses, the digital records indicating rights associated with software licenses (0005; 0015; 0121).

What Aldis et al does not explicitly teach is

under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record.

Aldis et al however teaches that the digital license can be distributed in a license pack. A license pack is contains one or more digital licenses. Arguably a license pack is

Art Unit: 3621

equivalent to the multiple software licenses in a batch mode as disclosed by present invention (see figs. 4 and 5; 0008; 0010; 0011; 0019; 0139; 0070; "license packs").

Ross et al however discloses a method comprising: under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record (see abstract; col. 1, line 65-col. 2, line 10; col. 30-35)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method wherein under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record as taught by Ross et al in order to ensure availability of various product versions and user satisfaction.

2. As per claim 2, 11, 20, 30, 44, 58, 68, 78, 88, 97, 111, 121, Aldis et al further discloses the method, wherein the upgrading or downgrading of rights is associated with the license key (0019; 0070).

3. As per claim 3, 12, 21, 31, 45, 59, 69, 79, 89, 98, 112, 122, Aldis et al further discloses the method, wherein the digital record is accessed using a web application (see fig. 1; 0065; 0066 0147; "web browser or API").

Art Unit: 3621

4. As per claim 4, 13, 22, 32, 46, 60, 70, 80, 90, 99, 113, and 123, Aldis et al further discloses the method, wherein the web application uses role-based security (0005).
5. As per claim 5, 14, 23, 33, 47, 61, 71, 81, 91, 100, 114, 124, Aldis et al further discloses the method, wherein digital records contain configuration information for the computer authorized to run the software (0010; 0072; "...hardware fingerprint of computer requesting activation code...").
6. As per claim 6, 15, 24,, 34, 48, 62, 72, 82, 92, 101, 115, 125, Aldis et al further discloses the method, wherein the digital records can be searched to find a specific digital record (0078; 0121; 0124; "...search and view licenses created...").
7. As per claim 7, 16, 25, 35, 49, 63, 73, 83, 93, 102, 116, 126, Aldis et al further discloses the method, wherein the rights are associated with a license key (0019; 0070).
8. As per claim 8, 17, 26, 36, 50, 64, 74, 84, 94, 103, 117, 127, Aldis et al further discloses the method, wherein configuration information for the computers running the software is stored in the digital record (0010; 0072).
9. As per claim 28, 38, 52, 66, 76, 86, 105, 119, 129, Aldis et al further discloses the method, wherein upgrading or downgrading of the version is done for multiple

Art Unit: 3621

software licenses in a batch mode (0019; 0070; "license packs").

10. As per claim 40, 54, 107, Aldis et al further discloses the method, wherein the list is obtained from another source (fig. 7).

11. As per claim 41, 55, 108, Aldis et al further discloses the method, wherein the list is obtained from a license generation system (fig. 4).

12. As per claims 43, 57, and 110, Aldis et al further discloses the method, wherein the list is provided to the software user as a pull down list (0102).

13. As per claim 75, 85, 128, Aldis et al further discloses the method, wherein the license version can also be upgraded (0103).

Claims 9, 18, 27, 37, 51, 65, 95, 104, and 118, are rejected under 35

U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 as applied to claims 1, 10, 19, 29, 39, 53, 67, 77, 87, 96, and 106 above, and further in view of Horstmann U.S. Patent No.

14. As per claim 9, 18, 27, 37, 51, 65, 95, 104, and 118, both Aldis et al and Ross et al failed to explicitly disclose the method, wherein the license version is downgraded.

Art Unit: 3621

Horstmann discloses the method, wherein the license version is downgraded (fig. 1; col. 2, line 60-col. 3, line 15).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein the license version is downgraded as taught by Horstmann in order to ensure availability of various product versions and/or user satisfaction.

Claims 42, 56, and 109, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 as applied to claims 39, 53, and 106 above, and further in view of Biddle U.S. Patent Application No. 2002/0107809 A1

15. As per **claims 42, 56, and 109**, both Aldis et al and Ross et al failed to explicitly disclose the method, wherein the list is transferred as an XML file.

Biddle et al discloses the method, wherein the list is transferred as an XML file (0051).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein wherein the list is transferred as an XML file as taught by Biddle et al in order to show the data type or language used.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Zhao U.S. Patent 6,081,840 is a document considered relevant to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

Or faxed to:

(571) 273-8300. [Official communications; including After Final communications labeled "Box AF"].

Art Unit: 3621

(571) 273-8300. [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

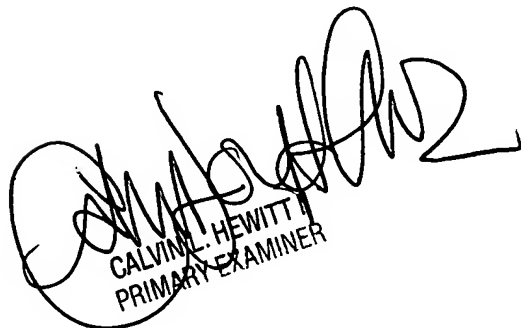
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Charlie Lion Agwumezie
Patent Examiner
Art Unit 3621
June 30, 2006



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